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09/550,348	04/14/2000	Anand Rangarajan	P3919	8679

  

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EXAMINER	
CAMPBELL, JOSHUA D	

  

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2178	

  

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/550,348

Applicant(s)

RANGARAJAN ET AL.

Examiner

Joshua D. Campbell

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is responsive to communications: RCE filed on 3/22/2007.
2. Claims 1-17 and 19 are pending in this case. Claims 1, 9, 15, and 19 are independent claims. Claims 1, 9, 15, and 19 have been amended.

### ***Claim Rejections - 35 USC § 112***

3. Claims 1-17 and 19 remain rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Having the user request to view summary information for the site after the registration process for that site is complete before being able to add summary information from non-solicited sites or sites the user is not registered to is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The final limitation in the independent claims states that the registration notification of the independent claims now includes, "...summarized information pertinent to the user from the site, including links to or information from alternate sites not solicited by, or registered to by the user," which is not enabled by the specification without taking steps prior to supplying this user with this information. The specification does not assert that the registration notification could include this additional information, rather the specification discloses specifically "...if a user requests summary about data on one of his sites such as, perhaps, current interest rates and re-finance costs at his mortgage site, the service may at it's own discretion provide an additional unsolicited summary from an alternate mortgage site for comparison," (page

32, lines 7-16 of applicant's specification) as a basis for when to provide unsolicited summaries. It is noted that this statement requires that the registration process for the site must have been completed and that a separate request for data must be generated to view summaries, at which point the summary data of unsolicited sites may be added to the output document. However, the claim states that as a part of the registration process, i.e. the notification that registration has completed, is where this data is presented even though the specification is silent to this fact. Additional information on providing unsolicited summaries is provided by that applicant in the specification (page 37, line 26-page 38, line 6 of applicant's specification) however, just as earlier in the specification the summary data is not included as part of a notification of registration. The applicant must either correct the claims to enable them or specifically point out where in the specification this limitation can be properly drawn, a mere allegation that the limitations as presented are enabled will not be enough to overcome this rejection.

In an effort to correct the lack of enablement detailed above, the applicant has amended the independent claims accordingly, "...a function for navigating to the site and submitting data to a host sponsoring the site using the form associated with the site, the data including at least a request for summarized information pertinent to the user," however this new amendment also lacks enablement according to the specification. The limitation explicitly states, "...submitting data to a host sponsoring the site using the form associated with the site," this form being a registration form for registering the user to the site. At no point in the specification does the applicant provide any support for making requests for summary data via registration forms, mainly

because the registration forms do not support data requests, rather they are used to allow registration to a site. The data that is submitted to the site via a form is for registration purposes only as detailed in the specification, thus it is not enabled to include a request for summarized information. The applicant must either correct the claims to enable them or specifically point out where in the specification this limitation can be properly drawn, a mere allegation that the limitations as presented are enabled will not be enough to overcome this rejection.

***Claim Rejections - 35 USC § 103***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claims 1-6, 15-16, and 19 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Light et al. (hereinafter Light, US Patent Number 6,192,380, filed on March 31, 1998) in view of Burson et al. (hereinafter Burson, US Patent Number 6,405,245, US filing date of October 28, 1998).

**Regarding independent claim 1**, Light discloses a method in which a form recognition unit detects properties about a form and a website containing a form (column 2, line 63-column 3, line 47 of Light). A matching unit then decides what data should be place in the form and at what locations, at which point the data and instructions on what to do with it (job order) is sent to the fill-in unit (column 3, line 48-column 4, line 30 of Light). The job order is an instruction that is executable by the fill-in

unit and the instruction includes data necessary to navigate to and register (fill-in the form) to a site, which could include information such as an authentication password (column 3, line 30-column 4, line 30). The fill-in unit then submits the data into the form and ultimately submits the form to the host (column 3, line 48-column 4, line 30 of Light). Then, any new form information necessary for the site is added to the database containing a user's form data (column 4, lines 5-36 of Light). Light does not disclose a method in which user notification is returned to the user that includes the result of the form submission and registration attempt, including registration status, authentication data, summary information including information from alternate sites not registered to by the user.

However, Burson discloses a method in which a user notification is returned from PI engine, which includes the results of the form submission, registration status and authentication data, and information from alternate sites not yet registered (list of all possible accessible PI) to by the user (column 6, line 66-column 7, line 17 and column 8, line 1-column 9, line 17 of Burson). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of Light with the method of Burson because it would have allowed the user to track transaction results with all sites.

**Regarding dependent claims 2-4,** Light discloses a method in which forms are found on web pages on the Web (Internet) (column 1, lines 7-40 of Light).

**Regarding dependent claim 5**, Light discloses a method in which forms are filled out with information such as credit card numbers to pay for a service (Figure 6 and column 3, lines 5-59 of Light).

**Regarding dependent claim 6**, Light discloses a method in which the form-filling process is completely controlled by a single networked system (server) (Figure 3 and column 2, line 53-column 3, line 47 of Light).

**Regarding independent claim 15**, the claim incorporates substantially similar subject matter as claim 1. Thus the claim is rejected along the same rationale as claim 1.

**Regarding dependent claim 16**, the claim incorporates substantially similar subject matter as claims 2-4. Thus, the claim is rejected along the same rationale as claims 2-4.

**Regarding independent claim 19**, Light discloses a method in which a form recognition unit detects properties about a form and a website containing a form (column 2, line 63-column 3, line 47 of Light). A matching unit then decides what data should be place in the form and at what locations, at which point the data and instructions on what to do with it (job order) is sent to the fill-in unit (column 3, line 48-column 4, line 30 of Light). The job order is an instruction that is executable by the fill-in unit and the instruction includes data necessary to navigate to and register (fill-in the form) to a site, which could include information such as an authentication password (column 3, line 30-column 4, line 30). The fill-in unit then submits the data into the form and ultimately submits the form to the host (column 3, line 48-column 4, line 30 of

Light). Then, any new form information necessary for the site is added to the database containing a user's form data (column 4, lines 5-36 of Light). Light discloses a method in which the system stores new form information obtained from a site once the form filling process is complete (column 4, lines 5-36 of Light). Light does not disclose a method in which user notification is returned to the user that includes the result of the form submission and registration attempt, including registration status, authentication data, summary information including information from alternate sites not registered to by the user.

However, Burson discloses a method in which a user notification is returned from PI engine, which includes the results of the form submission, registration status and authentication data, and information from alternate sites not yet registered (list of all possible accessible PI) to by the user (column 6, line 66-column 7, line 17 and column 8, line 1-column 9, line 17 of Burson). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of Light with the method of Burson because it would have allowed the user to track transaction results with all sites.

6. Claim 7, 9-12, and 14 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Light et al. (hereinafter Light, US Patent Number 6,192,380, filed March 31, 1998) in view of Burson et al. (hereinafter Burson, US Patent Number 6,405,245, US filing date of October 28, 1998) as applied to claims 1 and 3 above, and



further in view of Jacobs et al. (US Patent Number 5,611,048, issued on March 11, 1997).

**Regarding dependent claim 7**, neither Light nor Burson disclose a method of distributing software functions over a plurality of server nodes. However, Jacobs et al. discloses that functions to be performed on a server can be divided across multiple servers (column 4, lines 9-17 of Jacobs et al.). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Light and Burson with the method of Jacobs et al. because it would have optimized the efficiency of the method of Light by splitting the workloads among multiple servers.

**Regarding independent claim 9**, Light discloses a method in which a form recognition unit detects properties about a form and a website containing a form (column 2, line 63-column 3, line 47 of Light). A matching unit then decides what data should be place in the form and at what locations, at which point the data and instructions on what to do with it (job order) is sent to the fill-in unit (column 3, line 48-column 4, line 30 of Light). The job order is an instruction that is executable by the fill-in unit and the instruction includes data necessary to navigate to and register (fill-in the form) to a site, which could include information such as an authentication password (column 3, line 30-column 4, line 30). The fill-in unit then submits the data into the form and ultimately submits the form to the host (column 3, line 48-column 4, line 30 of Light). Then, any new form information necessary for the site is added to the database containing a user's form data (column 4, lines 5-36 of Light). Light does not disclose a

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method in which user notification is returned to the user that includes the result of the form submission and registration attempt, including registration status, authentication data, summary information including information from alternate sites not registered to by the user.

However, Burson discloses a method in which a user notification is returned from PI engine, which includes the results of the form submission, registration status and authentication data, and information from alternate sites not yet registered (list of all possible accessible PI) to by the user (column 6, line 66-column 7, line 17 and column 8, line 1-column 9, line 17 of Burson). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of Light with the method of Burson because it would have allowed the user to track transaction results with all sites.

However, Jacobs et al. discloses that functions to be performed on a server can be divided across multiple servers (column 4, lines 9-17 of Jacobs et al.). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Light and Burson with the method of Jacobs et al. because it would have optimized the efficiency of the method of Light by splitting the workloads among multiple servers.

**Regarding dependent claims 10-12,** the claims incorporate similar subject matter as claims 2-4. Thus, the claims are rejected along the same rationale as claims 2-4.

**Regarding dependent claim 14**, neither Light nor Burson disclose a method of distributing software functions over a plurality of server nodes, which are connected to each other via a dedicated data network. However, Jacobs et al. discloses that functions to be performed on a server can be divided across multiple servers that are connected to each other via a local area network (column 4, lines 9-17 of Jacobs et al.). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Light and Burson with the method of Jacobs et al. because it would have optimized the efficiency of the method of Light by splitting the workloads among multiple servers.

7. Claims 8, 13, and 17 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Light et al. (hereinafter Light, US Patent Number 6,192,380, filed March 31, 1998) in view of Burson et al. (hereinafter Burson, US Patent Number 6,405,245, US filing date of October 28, 1998) as applied to claims 1, 3, 9, 10, and 15 above, and further in view of Kraft et al. (US Patent Number 6,084,585, with US filing date of December 5, 1997).

**Regarding dependent claims 8, 13, and 17**, neither Light nor Burson disclose a method in which the job order is written in XML. However, Kraft et al. discloses that executable instructions which can be thought of as job orders can be written in any programming language including XML (column 3, lines 35-40 of Kraft et al.). It would have been obvious to one of ordinary skill in the art at the time the invention was made

to have combined the methods of Light and Burson with the method of Kraft et al. because the use of different programming languages was interchangeable.

### ***Response to Arguments***

8. Applicant's arguments filed 9/15/2006 have been fully considered but they are not persuasive.

Regarding the arguments on pages 7-9, regarding the rejection of claims 1-17 and 19 under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling, the examiner contends that the rejection is still proper and thus will be maintained. The applicant argues that the limitation that states that the registration notification of the independent claims now includes, "...summarized information pertinent to the user from the site, including links to or information from alternate sites not solicited by, or registered to by the user," is enabled by the specification. However, the limitation is clearly not enabled by the specification without taking steps prior to supplying this user with this information. It is noted that this statement requires that the registration process for the site must have been completed and that a separate request for data must be generated to view summaries, at which point the summary data of unsolicited sites may be added to the output document. However, the claim states that as a part of the registration process, i.e. the notification that registration has completed, is where this data is presented even though the specification is silent to this fact. In the applicant's argument's the examiner's point is proven. The applicant argues, "In some cases, accepted values may be immediately used by the service to log-in on behalf of a

user and to obtain data from the site for a user if directed to do so by XML order (p 67, lines 3-9)," however nowhere does this statement say that the registration includes unsolicited information. Rather, just as the examiner has previously pointed out, it states that "In some cases accepted values may be used..." these accepted values being the notification of a successful registration, which are then used to make a request on behalf of a user, and as previously stated no information from unsolicited sites is provided until after this request is made. Thus, the rejection stands proper and the examiner will not withdraw the rejection.

In an effort to correct the lack of enablement detailed above, the applicant has amended the independent claims accordingly, "...a function for navigating to the site and submitting data to a host sponsoring the site using the form associated with the site, the data including at least a request for summarized information pertinent to the user," however this new amendment also lacks enablement according to the specification. The limitation explicitly states, "...submitting data to a host sponsoring the site using the form associated with the site," this form being a registration form for registering the user to the site. At no point in the specification does the applicant provide any support for making requests for summary data via registration forms, mainly because the registration forms do not support data requests, rather they are used to allow registration to a site. The data that is submitted to the site via a form is for registration purposes only as detailed in the specification, thus it is not enabled to include a request for summarized information. The applicant must either correct the claims to enable them or specifically point out where in the specification this limitation

can be properly drawn, a mere allegation that the limitations as presented are enabled will not be enough to overcome this rejection.

Regarding the arguments on pages 9-10, regarding the rejection of the claims under 35 U.S.C. 103(a), no actual arguments have been presented. The applicant argues based on the belief that the 112 rejection is improper that a rejection for the claims including that non-enabled limitation must be made. However, regardless of the fact that the examiner is maintaining the 112 rejection, it is important to point out that in the previous action the examiner very clearly pointed out in the rejection of the claims how the limitation that is believed to be not enabled is rejected based upon the art. "Light does not disclose a method in which user notification is returned to the user that includes the result of the form submission and registration attempt, including registration status, authentication data, summary information including information from alternate sites not registered to by the user. However, Burson discloses a method in which a user notification is returned from PI engine, which includes the results of the form submission, registration status and authentication data, **and information from alternate sites not yet registered** (list of all possible accessible PI) to by the user (column 6, line 66-column 7, line 17 and column 8, line 1-column 9, line 17 of Burson). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of Light with the method of Burson because it would have allowed the user to track transaction results with all sites." (emphasis added, current and previous office action, found in the rejection of independent claim 1). Thus, the examiner has properly rejected all of the limitations of the claims as written

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based upon the prior art regardless of whether or not they are enabled by the specification.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua D. Campbell whose telephone number is (571) 272-4133. The examiner can normally be reached on M-F (7:30 AM - 4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JDC  
May 9, 2007

  
STEPHEN HONG  
SUPERVISORY PATENT EXAMINER